

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HARTMUT MAYER
and
UWE HENN

Appeal No. 1999-2264
Application No. 08/549,074

HEARD: JANUARY 10, 2001

Before CALVERT, COHEN, and GONZALES, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 12, all the claims in the application.

The claims on appeal are drawn to a convertible top for a vehicle, and are reproduced in the appendix of appellants' brief.

Claims 1 to 12 stand finally rejected as unpatentable on the following grounds:

(1) For lack of compliance with 35 U.S.C. § 101, "because the invention as disclosed is non-operative" (examiner's answer, page 3);

(2) For failure to comply with the enablement requirement of 35 U.S.C. § 112, first paragraph;¹

(3) For failure to comply with 35 U.S.C. § 112, second paragraph.

Rejection (3)

We will first consider the question of compliance with § 112, second paragraph, i.e., definiteness, a requirement which is distinct from enablement. Process Control Corp. v. HydReclaim Corp., 190 F.3d 1350, 1358 n.2, 52 USPQ2d 1029, 1034 n.2 (Fed. Cir. 1999).

The basis of the rejection is stated at page 5 of the answer as:

The claims as amended are functional in that no structure for the function of [the piston rod] "configured to be supplied with oil under pressure to the working

¹The language used by the examiner in the first paragraph of section 4 on page 5 of the examiner's answer relates to the written description requirement of § 112, first paragraph, but it is evident from the examiner's further statements that the basis of this rejection is non-enablement.

cylinder (6)" is recited.^[2]

We do not consider this rejection to be well taken.

A claim is in compliance with the second paragraph of § 112 if it reasonably apprises those of skill in the art of its scope. In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). In our view, the present claims meet this criterion. Even assuming that the limitation quoted by the examiner is functional, that does not render the claims indefinite per se, because "[t]here is nothing intrinsically wrong in defining something by what it does rather than by what it is." In re Echerd, 471 F.2d 632, 635, 176 USPQ 321, 322 (CCPA 1973). Here, we are of the opinion that the language of appellants' claims 1 to 12 is such as to reasonably apprise those of ordinary skill in the art of their scope.

Rejection (3) therefore will not be sustained.

Rejections (1) and (2)

These rejections will be considered together since the questions of whether a specification provides an enabling disclosure under § 112, first paragraph, and whether an

²The quotation is taken from claim 1, the only independent claim, except that the examiner has added the numeral "(6)" at the end.

application satisfies the utility requirement of § 101 are closely related. In re Swartz, 232 F.3d 862, 863, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000).

The instant application discloses a mechanism for raising and lowering the convertible top of a vehicle. A hollow piston rod 2 having a piston 5 at its center is fastened at both ends to convertible top bearing 1. A cylinder 3 (also 6) is slidable on the piston rod and connected at its end 7 with top drive lever 8. As disclosed at page 4, lines 18 to 20, "oil is conducted under pressure through holes 9 in the piston rod 2 into the respective cylinder of the working cylinder 3." Supplying oil into the left end 4 of the piston causes the cylinder 3 to slide on the piston rod, moving the top from the closed position (Fig. 1A) to the fully-open position (Fig. 1C) (page 5, lines 12 to 15).³

The examiner notes, and correctly so, that no structure is disclosed whereby the oil in the piston rod 2 can cause movement of the cylinder 6. Appellants argue at pages 8 to 10 of the

³At page 5, lines 16 to 22, it is stated that the top is opened by supplying oil through the right end of the piston rod, to displace the cylinder rightwardly, and closed by applying oil through the left end of the piston rod, displacing the cylinder leftwardly. These directions are contrary both to the disclosure on page 5, lines 12 to 15, and to the showing in the drawings, and should be corrected in subsequent prosecution.

brief that "almost anyone with any mechanical skill, not just the person of ordinary skill in this art, would immediately know how to provide the relative movement [of the cylinder 6 on the piston rod 2]," and provide a drawing showing where holes "A" and "B" would be located in the wall of the piston rod 2 to pass the oil to the interior of the cylinder 6. The examiner replies at page 6 of the answer that there is no evidence to support appellants' above-quoted statement, and that "evidence of prior art structure should have been provided."

The test for compliance with the enablement requirement of § 112, first paragraph, is whether the application adequately discloses the claimed invention so as to enable a person skilled in the art to practice the invention at the time the application was filed without undue experimentation. In re Swartz, supra. In order to reject a claim for lack of enablement, the examiner has the initial burden of producing reasons that substantiate the rejection. In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); In re Marzocchi, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971). Once that is done, the burden shifts to the applicants to rebut this conclusion by presenting evidence to prove that the disclosure in the specification is enabling. In re Wright, supra; In re Eynde, 480 F.2d 1364, 1370,

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178 USPQ 470, 474 (CCPA 1973).

In the present case, assuming arguendo that the examiner met the initial burden, appellants had the burden of presenting evidence, e.g., in the form of affidavits under 37 CFR § 1.132 or prior patents, to rebut the examiner's conclusion by showing that one skilled in the art would have known how to make and use the claimed invention. See M.P.E.P. § 2164.05 (Feb. 2000). This appellants did not do, but merely argued as discussed above; such argument cannot take the place of evidence, In re Wiseman, 596 F.2d 1019, 1022, 201 USPQ 658, 661 (CCPA 1979), and normally would be insufficient to overcome the rejection. Here, however, considering the nature of the deficiency in appellants' disclosure, we note that there is evidence in the record in the form of Iwata Pat. No. 5,014,062. This patent discloses a fixed, hollow piston rod 1 with a piston 5 at its center and a cylinder 4 slidably mounted thereon. It further discloses bores 9, 9' through the wall of the piston rod so that fluid from the piston rod can pass to the interior of the cylinder to cause it to move back and forth (col. 2, lines 47 to 54). We further note that Iwata was applied in the first Office action (Paper No. 5), the examiner pointing out its disclosure of bores 9, 9'. In our view, the Iwata patent constitutes sufficient evidence that, as

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of appellants' filing date, one of ordinary skill in the art would have been able to make and use the claimed invention without undue experimentation.

Rejections (1) and (2) therefore will not be sustained.⁴

Conclusion

The examiner's decision to reject claims 1 to 12 is reversed.

REVERSED

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IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
IRWIN CHARLES COHEN)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JOHN F. GONZALES)	
Administrative Patent Judge)	

IAC:hh

⁴Our conclusion that the application is in compliance with the enablement requirement of § 112, first paragraph, should not, however, be taken as an indication that appellants should not be required to amend the specification and drawings as the examiner may deem necessary to provide a complete disclosure.

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